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IN THE

Supreme Court of the United States

OCTOBER TERM, 1979

No. 79-454

SHURE BROTHERS, INCORPORATED,
Petitioner,

vs.

KORVETTES, INC., d/b/a E. J. KORVETTE,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

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SHURE BROTHERS, INCORPORATED,
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KORVETTES, INC., d/b/a E. J. KORVETTE,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

The petitioner, Shure Brothers, Incorporated, petitions that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Seventh Circuit entered in this action on May 25, 1979, so that this Court may resolve a direct conflict on an identical issue and identical patents between the decision of the Court of Appeals affirming summary judgment and a contrary judgment after full trial in another circuit, which has caused widespread confusion and uncertainty concerning two patents of unusual public importance.

REFERENCE TO THE OFFICIAL AND UNOFFICIAL REPORTS OF THE OPINIONS DELIVERED IN THE COURTS BELOW.

The opinion of the Court of Appeals below has not been reported, by the express direction of that Court. There are two opinions of the District Court below. One is reported unofficially at 198 U. S. P. O. 283. The other is unreported. All three opinions are appended, in pertinent part, at A1, A2 and A11, respectively.

THE GROUND ON WHICH THE JURISDICTION OF THIS COURT IS INVOKED.

The judgment sought to be reviewed was entered on May 25, 1979. A timely petition for rehearing was denied by order dated June 21, 1979. The jurisdiction of this Court is invoked under 28 U. S. C. § 1254(1).

THE QUESTION PRESENTED FOR REVIEW.

Did the Seventh Circuit Court of Appeals err in affirming a partial summary judgment of non-infringement of U. S. Letters Patent Nos. 3,077,521 and 3,077,522 granted by the United States District Court for the Northern District of Illinois that the preambles of stereo phonograph stylus patent claims limit the scope of the patent grant, where such decision is in direct conflict with the unappealed judgment after trial of the United States District Court for the District of Maryland in *Shure Brothers, Inc.* v. *Peeltone, Inc.*, No. HM-76-722 (D. Md. Dec. 5, 1978) on the identical patents and the identical issue, and where such conflict has created widespread confusion and uncertainty in the stereo phonograph industry and with the purchasing public concerning their rights to make, use and sell the patented stereo phonograph stylus.

CONSTITUTIONAL PROVISIONS, STATUTES AND REGULATIONS INVOLVED.

The constitutional provisions which this case involves is Article I, Section 8:

> "ART. I. SEC. 8. The Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

The statutes involved are 35 U. S. C. §§ 112 and 271:

> § 112. Specification
>
> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.
>
> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
>
> 271. Infringement of patent
>
> (a) Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent.

The regulations involved are 37 C. F. R. § 1.75(a), (b) and (e):

> § 1.75 Claims(s).
>
> (a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.
>
> (b) More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied.

(e) Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order, (1) a preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known, (2) a phrase such as "wherein the improvement comprises," and (3) those elements, steps and/or relationship which constitute that portion of the claimed combination which the applicant considers as the new or improved portion.

No treaties are involved.

STATEMENT OF THE CASE.

I.

Basis for Federal Jurisdiction in the Court of First Instance.

The jurisdiction of the District Court below was based on 28 U. S. C. § 1338, since this is a civil action for patent infringement.

II.

The Nature of the Case and the Disposition in the Court Below.

The plaintiff-appellant, Shure Brothers, Inc. (hereinafter "Shure") brought this action against the defendants for, *inter alia*, infringement of U. S. Patents Nos. 3,077,521 (App. 13[1]) and 3,077,522 (App. 46) (hereinafter, respectively, "the '521 patent", "the '522 patent" and collectively, "the patents in issue"). The only question finally decided by the District Court and Court of Appeals below concerns the issue of infringement of the patents in issue. All other pleaded issues still remain to be tried by the District Court.

The patents here involved concern sterophonic phonograph equipment. Specifically, they concern moving magnet phonograph pickup cartridges and styli intended for use in such cartridges. The styli are most often known as "needles", but are called "armature-stylus subassemblies" in the vernacular of the patents in issue. For ease of understanding, these subassemblies are referred to hereinafter as such and as "the patented styli".

The Court of Appeals for the Seventh Circuit and the U. S. District Court for the Northern District of Illinois (hereinafter "the Illinois District Court") have found as a matter of law

1. References to the record designated "App. XX" are to the Appendix to Plaintiff-Appellant's Brief in the Court of Appeals; references designated "A. XX" are to the Appendix to this Petition.

that the claims of the patents in issue cover only a phonograph cartridge in combination with a phonograph stylus and do not cover a phonograph stylus alone. The U. S. District Court for the District of Maryland (hereinafter "the Maryland District Court") has made a directly contrary finding that the patent claims cover a phonograph stylus *per se* and are not limited to a cartridge and stylus combination.

Claim 7 of the '521 patent is representative of the pertinent claims of the patents in issue:

> 7. An armature-stylus subassembly for a magnetic pick-up cartridge comprised of two electromagnet systems each terminating in a pair of spaced-apart pole pieces arranged to describe a common magnetic gap and to form a socket having a recess substantially co-extensive with said gap; said subassembly comprising
>
> a supporting member,
>
> a bearing of an elastomeric material having a channel therein retained within said supporting member,
>
> an armature comprising a permanent magnet operatively mounted in said bearing channel for angular vibration substantially about a point intermediate the poles of said magnet, and
>
> means including a stylus connected with said armature for transmitting vibrations thereto,
>
> the portion of said supporting member containing said armature and said bearing being contoured so that it may be inserted axially into the recess of said socket at said common gap and, when so inserted, orients and retains said gap in operating position.

Thus, each of the pertinent patent claims of the patents in issue has a preamble which sets forth an armature stylus subassembly for use in a phonograph cartridge. After such a preamble, the body of the claim defines the novel elements of the stylus construction. The question, decided differently by the Illinois and Maryland District Courts, is whether the reference in the body of the patent claims to the cartridge environment set

forth in the preambles limits the claims to a cartridge and stylus combination or whether the claims define a novel stylus construction *per se* as adapted for use in its cartridge environment.

The patents in issue, their file wrapper histories and the prior art before the U. S. Patent and Trademark Office reveal that the patented stylus in issue was patentable separate from a cartridge construction (App. 91), that the patentees clearly intended the pertinent patent claims to cover only a novel stylus *per se* (*e.g.*, App. 88), that the patentees repeatedly expressed their intention to cover only a stylus in these patent claims (*e.g.*, App. 88), and that the U. S. Patent and Trademark Office fully acquiesced in and agreed to this claim construction (*e.g.*, App. 91).[2]

The defendant-appellee, Korvettes, Inc., d/b/a E. J. Korvette (hereinafter "Korvettes"), admittedly distributes and sells armature-stylus subassemblies (App. 92), which are alleged to be exact copies of the patented styli (A. 1). In the Illinois District Court, Korvettes was granted a partial summary judgment of non-infringement. Appeal to the Seventh Circuit Court of Appeals followed this judgment.

Subsequent to the summary judgment of the Illinois District Court, but before decision by the Court of Appeals below, trial on a substantially identical set of facts and legal issues as presented to the Illinois District Court took place in *Shure Brothers, Inc.* v. *Peeltone, Inc.*, Civil Action No. HM-76-722 (D. Md. Dec. 5, 1978). The primary non-infringement defense asserted by the defendant Peeltone, Inc. in the Maryland action was the summary judgment granted by the Illinois District Court. However, after a five week jury trial on the merits, during which considerable evidence was introduced on the scope of the patents in issue, the Maryland District Court orally ruled on a motion for directed verdict that the patents in issue did claim a phonograph stylus *per se* and were not limited to a stylus in combi-

2. A thorough analysis of the patents in issue, their file wrapper histories and the prior art before the U. S. Patent and Trademark Office during prosecution is found in Plaintiff-Appellant's Brief in the Court of Appeals at 6.

nation with a phonograph cartridge, in direct opposition to the summary judgment granted by the District Court below (A. 14).[3]

The directed verdict of the Maryland District Court, given after a full trial on the merits, has not been appealed, and time for such an appeal has expired. This contrary decision of the Maryland District Court was totally ignored by the Court of Appeals below in its affirmance of the Illinois District Court summary judgment (A. 1).

ARGUMENT: THE DECISION OF THE COURT OF APPEALS IS A MANIFESTLY ERRONEOUS SUMMARY DECISION WHICH IS IN CONFLICT WITH AN AFTER-TRIAL DECISION IN ANOTHER CIRCUIT ON THE IDENTICAL ISSUE AND PATENTS, AND THEREBY HAS CAUSED WIDESPREAD CONFUSION AND UNCERTAINTY CONCERNING TWO PATENTS OF UNUSUAL PUBLIC IMPORTANCE.

I.

The Decision of the Court of Appeals Is Manifestly Erroneous.

The decision of the Court of Appeals below (A. 1) is based solely upon the erroneous reasoning that a patent claim which has a preamble describing a novel environmental setting for a novel phonograph stylus and a claim body describing the elements of the novel stylus with reference to the cartridge environment cannot, as a matter of law, be infringed by the manufacture, use or sale of the phonograph stylus alone.

Contrary to the decisions by the Court of Appeals and the Illinois District Court, a decision on the meaning and scope of such patent claims can never be so simple as to be determined in a summary manner by consideration of the claim language alone. As this Court has frequently admonished, patent claims cannot—indeed, must not—be interpreted in a vacuum. Claims must be read with reference to the prior art. *E.g.*, *Hoff* v. *Iron*

3. A clarification of the language of the Maryland District Court is found in Plaintiff-Appellant's Reply Brief in the Court of Appeals at 2.

Clad Mfg. Co., 139 U. S. 326 (1891) ("To ascertain the exact scope of this patent it is necessary to examine the state of the art at the time it was issued.") They must be read with reference to the *full* patent file wrapper. *E.g.*, *Crawford* v. *Heysinger*, 123 U. S. 589 (1887) ("The file wrapper and contents in the matter of [the application] are part of the evidence in the case, and throw light upon what should be the proper construction of [the claims]".) They must be read with reference to rejected claims and other allowed claims. *E.g.*, *Graham* v. *John Deere Co.*, 383 U. S. 1 (1966) ("Claims as allowed must be read and interpreted with reference to rejected ones . . ."). And they must be read, where meritorious invention exists, to secure to the patentee his actual invention. *Smith* v. *Snow*, 294 U. S. 1 (1935).

In sum, the claims of a patent are to be interpreted as are clauses of any other legal instrument: with reference to *all* the other terms of the instrument and *all* the circumstances surrounding its inception, with a view toward effecting the intentions of the parties to the instrument. 35 U. S. C. § 112; *Doble Engineering Co.* v. *Leeds & Northrup Co.*, 134 F. 2d 78 (1st Cir. 1943). ("[A]s we see it our problem is to determine first what a patentee intended to claim as his invention or discovery and second upon what invention or discovery the patent office intended to grant a temporary monopoly.") All useful information is to be inspected, in order to "reach what Justice Holmes called the 'felt meaning' of the claim." *Autogiro Co. of America* v. *United States*, 384 F. 2d 391 (Ct. Cl. 1967).

Despite these and other well-known precepts of patent claim construction, both the Illinois District Court and the Court of Appeals below ignored nearly all of the essential underlying information which should have been the very foundation of their decisions. As an example, they ignored the highly pertinent fact that during prosecution of the patents in issue, the patentees repeatedly expressed to the Patent and Trademark Office their intention that the claims of the patents in issue cover the phono-

graph stylus alone, and the further pertinent fact that this intention was never contested by the Patent Examiner.[4]

The gravity of the error in the decision of the Court of Appeals below is best evidenced by contrasting the summary manner with which the Court of Appeals below reached its conclusion to the notable struggle other courts have had with patent claims of similar form. According to the Illinois District Court itself, "[t]he question of whether a preamble in a patent claim should be treated as a limitation thereon is one which has often troubled courts." (A. 8) In fact, over twenty-two lower court decisions[5] have addressed this question in the last thirty

4. The only matter that the Illinois District Court or the Court of Appeals below relied upon, other than the claims themselves, was an expansion of the preambles prior to allowance of the claims. However, the patentees were certainly entitled to no less than a fair construction of their claims through consideration of all the evidence that was of record, *Hubbell* v. *United States,* 179 U. S. 77 (1900), rather than a wooden prejudgment of file wrapper estoppel. The goal is to be reward meritorious invention, not punish questioned semantics. *Autogiro, supra* at 399; *Laser Alignment, Inc.* v. *Woodruff & Sons, Inc.,* 491 F. 2d 866, 876 (7th Cir. 1974).

5. Decision of the Court of Appeals below; *Wells Mfg. Corp.* v. *Littelfuse, Inc.,* 547 F. 2d 346 (7th Cir. 1976); *Super Products Corp.* v. *D P Way Corp.,* 546 F. 2d 748 (7th Cir. 1976); *Marston* v. *J. C. Penney Co.,* 353 F. 2d 976 (4th Cir. 1965), *cert. denied,* 385 U. S. 974 (1966); *In re Wertheim,* 541 F. 2d 257 (C. C. P. A. 1976); *In re Hirdo,* 535 F. 2d 67 (C. C. P. A. 1976); *In re Higbee,* 527 F. 2d 1405 (C. C. P. A. 1976); *In re Pearson,* 494 F. 2d 1399, 1402-03 (C. C. P. A. 1974); *In re Freeman,* 474 F. 2d 1318, 1323 (C. C. P. A. 1973); *In re Myers,* 410 F. 2d 420, 426-27, (C. C. P. A. 1969); *In re Szajna,* 422 F. 2d 443 (C. C. P. A. 1970); *In re Duva,* 387 F. 2d 402, 406-07 (C. C. P. A. 1967); *In re Walles,* 366 F. 2d 786, 790 (C. C. P. A. 1966); *In re Van Lint;* 354 F. 2d 674 (C. C. P. A. 1966); *Application of Dunn,* 349 F. 2d 433 (C. C. P. A. 1965; *In re Sinex,* 309 F. 2d 488, 492 (C. C. P. A. 1962); *In re DeNapoli,* 302 F. 2d 768, 770 (C. C. P. A. 1962); *Kropa* v. *Robie,* 187 F. 2d 150 (C. C. P. A. 1951) (37 previous C. C. P. A. cases are cited therein); *Shure Brothers, Inc.* v. *Peeltone, Inc.,* Civil Action No. HM-76-722 (D. Md. Dec. 5, 1978); *Pettibone Corp.* v. *Fargo Machine & Tool Co.,* 447 F. Supp. 1278 (E. D. Mich. 1978); *Diamond Int'l Corp.* v. *Maryland Fresh Eggs, Inc.,* 374 F. Supp. 1223 (D. Md. 1974), *rev'd. on other grounds,* 523 F. 2d 113 (4th Cir. 1975); and *Ex parte Lennon,* 140 U. S. P. Q. 67 (P. O. Bd. App. 1963).

years, most with significant struggle.[6] Indeed, much of the struggle has concerned the interpretation of *Ex parte Jepson,*[7] or improvement, patent claims, where Patent Office rules of practice have dictated for years that any structure recited in a claim preamble is part of the claimed combination. 37 C. F. R. § 1.75(e); *Wells Mfg. Co.,* Fn. 5 *supra* at 352. Where the claims are not in *Ex parte Jepson* form, as here, the struggle is even more pronounced.

In light of these decisions, the reliance of the Court of Appeals below upon an oft-quoted but little applied "notion"[8] which applies strictly to *Ex parte Jepson* patent claims, a type of claim not here involved, along with the concomitant failure to analyze pertinent facts of record, was manifest error.[9]

II.

THE DECISION OF THE COURT OF APPEALS HAS CAUSED WIDESPREAD CONFUSION AND UNCERTAINTY CONCERNING TWO PATENTS OF UNUSUAL PUBLIC IMPORTANCE.

The summary affirmance of the Court of Appeals below has created a situation of widespread confusion and uncertainty for Shure and the public. The confusion and uncertainty exists because Shure has the legal right to enforce the patents in issue against infringing styli in one part of the country, under the

6. E.g., *Wells Mfg. Corp.* Fn. 5 *supra.*

7. 243 O. G. 525 (1917).

8. The word used by of the Illinois District Court. (A. 12).

9. The basis of the decisions below was apparently an errant belief that it is not fair for a patentee to claim both a combination and a subcombination, where the subcombination wears out faster than the combination, based upon a non-applicable interpretation of the doctrine of permissible repair, as stated in *Aro Mfg. Co.* v. *Convertible Top Replacement Co.,* 365 U. S. 336 (1961). In contradiction, such claiming has historic recognition and acceptance. *See,* Manual of Patent Examining Procedure, Chapter 800 (e.g., M. P. E. P. § 806.05 stating that claims in one patent to separate but related inventions are proper.).

judgment of the Maryland District Court, while Shure is denied enforcement against the same infringing styli in another part of the country, under the conflicting summary decisions of the Court of Appeals below and the Illinois District Court. Both Shure and the public stand in a position of undeserved confusion and uncertainty, without the aid of any precedental clarity for a distinction in the manifest conflict between the Illinois and Maryland Courts. Neither Shure's rights of patent enforcement against others are defined, nor the right of the public to know the legally applicable scope of the patents in issue in a market that is national in territory.

This is a serious matter of substantial public interest. The rights and conduct of a considerable purchasing public, the whole of the phonograph industry, and, more specifically, Shure's long-standing licensees and those it has previously alleged to be infringers, are all adversely affected. The interests of these many persons, along with the pioneer status of the inventions covered by the patents in issue, make the patents in issue patents of unusual public importance.

That there are many persons who are directly affected by the chaos created by the lower court decisions here involved is without dispute. Shure has a number of licensees under the patents in issue.[10] The phonograph styli of these licensees are used in great numbers throughout the United States.

Moreover, Shure has vigorously enforced the patents in issue against non-licensed infringing manufacturers and sellers of the patented styli in many informal disputes and in about eleven legal actions.[11] Shure has secured judgments against various

10. Shure has licensed all major U. S. manufacturers: Pickering & Co., Inc.; Recoton Corp.; Audio Dynamics Corp.; and Empire Scientific Corp.

11. This action; *Shure Brothers, Inc.* v. *Peeltone, Inc., supra; Shure Brothers, Inc.* v. *Fidelitone, Inc., et al.*, Civil Action No. 77 C 971 (N. D. Ill. Nov. 20, 1978); *Shure Brothers, Inc.* v. *Tower Records, Inc.*, Civil Action No. C 76-964 SW (N. D. Cal. stipulation

(Footnote continued on next page.)

infringers on the basis that pertinent claims of the patents in issue claim the patented phonograph styli *per se*.[12] Shure intends to maintain its enforcement of these patents against infringers, and in the absence of a uniformly applied, controlling decision otherwise, Shure will seek by all appropriate legal means to protect its important inventive contribution against the non-licensed manufacture, use or sale of the patented styli.

The pioneer status of the patents in issue is also closed to dispute. The stylus subassembly and phonograph cartridge inventions disclosed by the patents in issue were, upon their introduction, hailed by Consumers Union as "outstanding", the "highest achievement CU [Customers Union] has yet observed of the art of pickup design", providing a "quality of sound in the home that approaches live music to such a degree that it is startlingly beautiful", the only pickup that could "be recommended for hi-fi use without serious qualifications" and providing "a clarity and freedom from 'shatter' [distortion] second to no other pickup in CU's [Consumer Union's] experience."[13] An expert in the art at the time of introduction called the inventions "the major

(Footnote continued from preceding page.)

to stay Nov. 17, 1978); *Shure Brothers, Inc.* v. *Music Discount*, Civil Action No. 76-0493 (D. Col. Aug. 16, 1976); *Shure Brothers, Inc.* v. *Walder Electronic Distributors Co.*, Civil Action No. 74-1092-CIV-JE (S. D. Fla. Jan. 27, 1975); *Shure Brothers, Inc.* v. *Harold J. Schulman Associates, Inc.*, Civil Action No. 63 C 1306 (E. D. Ill. March 18, 1968); *Shure Brothers, Inc.* v. *Pickering & Co., Inc.*, Civil Action No. 63 C 1306 (N. D. Ill. March 15, 1968); *Shure Brothers, Inc.* v. *Empire Scientific Corp.*, Civil Action No. 63 C 1287 (E. D. N. Y. filed Dec. 5, 1963); *Shure Brothers, Inc.* v. *Recoton Corp.*, Civil Action No. 63 C 1288 (E. D. N. Y. July 21, 1967); *Shure Brothers, Inc.* v. *Audio Dynamics Corporation*, Civil Action No. 63 Civ 3622 (E. D. N. Y. June 17, 1965).

12. *E.g.*, Consent Judgment against Nagaoka & Co., Ltd., entered September 16, 1977 in *Shure Brothers, Inc.* v. *Fidelitone, Inc., et al.*, fn. 11 *supra*.

13. 24 Consumer Reports, "Stereo Pickups and Arms" 126 (March 1959).

breakthrough needed to give the impetus to the bandwagon of stereo disc reproduction."[14]

In view of the substantial and widespread public interest in the patents in suit, it is essential that there be uniform interpretation and application of these patents throughout the United States and that there be such a final disposition of the existing conflict as to provide clear guidance to the stereo phonograph trade and the consuming public. It is unsettling to all concerned that the same patent claims should cover a cartridge and a stylus subassembly combination in one part of the country, but only a stylus subassembly in another part of the country. Such circumstances *create* problems, and do not resolve them, as is the goal of proper judicial determination.

If this chaos is to be resolved, this Court must resolve it; if clear guidance is to be given the concerned public, this Court must give it. As stated, over twenty-two recent decisions of lower courts have addressed the issue of whether a preamble in a patent claim is a limitation on the claim. Fn. 5 *supra*. All the courts have been "troubled" with the issue (A. 8). According to a well-known patent law commentator, the decisions are "difficult to reconcile". 2 D. Chisum, Patents § 8.06[1] at 8-80 (1979). In truth, the Courts are not simply troubled: they are floundering. The decisions are not simply difficult to reconcile: they are impossible to reconcile. The decisions are at odds with each other, and even with themselves, when the facts presented to them are reviewed.

In this action, the Illinois District Court and the Court of Appeals below relied on the prior Seventh Circuit decision of *Wells Mfg. Corp.*, fn. 5 *supra*, as controlling on the non-*Ex Parte Jepson* patents in issue, even though *Wells Mfg. Corp.* expressly limited its holding to claims of *Ex Parte Jepson* form, *Wells Mfg. Corp.*, fn. 5 *supra* at 355, and even though a second, prior *and contradictory* Seventh Circuit decision, *Super Products*

14. H. Horowitz, "Moving Magnetic Stereo", *Audio* 19 (May 1959).

Corp., fn. 5 *supra*, should have controlled with respect to patent claims not in *Ex Parte Jepson* form. In *Marston*, fn. 5 *supra*, the Fourth Circuit stated the notion that was relied on in the Illinois District Court, *and then reached a result at odds with the notion.*[15]

Considering the erroneous lack of analysis in the Courts below as illustrative, further confusion, not clarification, can be expected from other courts on the patents in issue and the disputed issue. More reliance upon non-analytic and troublesome catch-phrases or notions is predictable, as in *Pettibone Corp.*, fn. 5 *supra*, where the unprecedented phrase "patent per se in situ" carried the day. And the issue will arise again and again, since patent practitioners are being encouraged by the best minds in their field to draft patent claims of the format which is subject to this issue.[16]

All this confusion is contrary to the basic purposes of the federal patent system, which are threefold: to reward invention, to promote disclosure of invention, and to assure that ideas which are in the public domain are known to be there. U. S. Const. Art. I, § 8; 35 U. S. C. §§ 112, 271; *Kewanee Oil Co.* v. *Bicron Corp.*, 416 U. S. 470, 480-81 (1974). Under the present situation, the general public, along with innumerable patentees and infringers throughout the United States, will face uncertainty over patent infringement liability for years to come. The public will be unsure of what is in the public domain. Patentees deserv-

15. In *Marston*, the preamble was not found to be a limitation upon the claim at issue even though the body of the claim did, in fact, refer to the preamble. The preamble recited "A buoyant, flexible filler pad" and the body included as an element "link sections . . . each said link section being in spaced relation to adjacent link sections of the laterally disposed strip portion to provide fluid circulating openings therebetween *extending perpendicularly through said pad.*" *Marston*, 353 F. 2d at 977. Significantly, the article found to infringe was no filler pad at all. *Id.* at 985-986.

16. *E.g.*, J. Laudis, Mechanics of Patent Claim Drafting 20 (2d ed. 1974) "The elements of an apparatus claim are the main structural parts which together make up the combination claimed. . . . The workpiece . . . should be recited in the preamble of the claim, not made an element of the claimed combination."

ing of legal protection may be denied that protection. Alleged infringers undeserving of threats of infringement and litigation may be burdened with just such threats and just such litigation.[17]

It is submitted that the parties, and the involved public as well, are entitled to clarification and resolution of the important intra-circuit and inter-court legal conflicts that have been generated. Consideration by the Supreme Court of the question presented is in the best interests of both justice and judicial economy, and is necessary to avoid further duplicative litigation.

In view of the gravity of the error of the Illinois District Court and the Court of Appeals below, the unusual public importance of the patents in issue, and the unusual public importance of the issue involved, allowance of the writ is requested.

Respectfully submitted,

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17. Such litigation is acknowledged to be extraordinarily costly, and wasteful of nationally important resources. *Blonder-Tongue Laboratories, Inc.* v. *University of Illinois Foundation*, 402 U. S. 313 (1970).

APPENDIX.

IN THE UNITED STATES COURT OF APPEALS
For the Seventh Circuit

No. 78-2336

SHURE BROTHERS, INCORPORATED, *Plaintiff-Appellant,*

vs.

KORVETTES, INC., d/b/a J. KORVETTE, *Defendant-Appellee.*

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

No. 77-C-1609

BERNARD M. DECKER, *Judge.*

ORDER.

The district court correctly identified and decided the question whether certain claims claimed a combination which the defendant did not infringe or a sub-assembly which defendant allegedly duplicated. The preambles to the relevant claims in patents '521 and '522 show a significant cooperative interrelationship between the magnetic phonograph pickup cartridge and the armature-stylus sub-assembly. This interrelationship cannot be ignored. *Wells Mfg. Corp.* v. *Littelfuse, Inc.*, 547 F. 2d 346 (7th Cir. 1976).

Appellant has not demonstrated in its brief or on oral argument that Judge Decker was mistaken in his reading of the claims and file wrappers. Although counsel suggested that the patentee's testimony might somehow develop an issue of fact, there is nothing in the record to suggest what such testimony would be.

The question was one of law, and there was no genuine issue of fact.

Judgment appealed from is AFFIRMED.

IN THE UNITED STATES DISTRICT COURT
For the Northern District of Illinois
Eastern Division

SHURE BROTHERS, INCORPORATED,
Plaintiff,
vs.
KORVETTES, INC., dba E. J. KORVETTE AND OGURA JEWEL INDUSTRY CO., LTD.,
Defendants.

Civil Action
No. 77-C-1609

MEMORANDUM OPINION AND ORDER.

This is an action for patent infringement brought by plainitff Shure Brothers, Inc. ("Shure") against Korvettes, Inc. ("Korvettes") and Ogura Jewel Industry Co., Ltd. ("Ogura"). Defendant Korvettes has moved for dismissal for failure to state a ground for relief under Rule 12(b)(6). Since this motion asserts matters outside of the pleadings and relies upon affidavits, it will be treated as a motion for summary judgment under Rule 56.

* * * * *

I.

The complaint alleges that the defendants are engaged in the infringement of and conspiracy to infringe three patents owned by Shure. These patents are United States Letters Patent Nos. 3,055,988 (the "-988 patent"), 3,077,521 (the "-521 patent") and 3,077,522 (the "-522 patent"). The patents concern phonograph pickup equipment. Specifically, they relate to moving magnet phonograph cartridges and styli (most often referred to as "needles"). The cartridge and stylus assembly is mounted

on the end of a tone arm, and the needle rides in the grooves of a phonograph record to create the electrical impulses that are amplified to drive the loudspeakers.

The complaint charges that Korvettes has infringed these patents by selling phonograph styli designed to fit into cartridges sold by Shure. In its answers to interrogatories, the plaintiff specifies one accused needle sold to Korvettes as Walco Model W582 STD (Interrogatory Answer No. 4) ("Walco Model"). In the same answer, the plaintiff lists the patent claims which are allegedly infringed as follows:

(1) -988 patent: Claim 6

(2) -521 patent: Claims 7 through 13 and 15

(3) -522 patent: Claims 2, 3, 4 and 6.

The motion for summary judgment is based on the defendant's contention that there is no genuine issue of fact that the Walco Model does not infringe claim 6 of the -988 patent and second that the -521 and -522 patent claims are for a combination, and the Walco Model stylus is merely replacement for an unpatented part.

* * * * *

B. *The -521 and -522 patents*

This aspect of the motion for summary judgment is based on the defendant's contention that the relevant claims in these two patents are in reality claims for a combination of an armature-stylus subassembly and a magnetic pickup cartridge. The defendant argues that since these claims refer to a combination, and Korvettes sells only one unpatented part, then as a matter of law, no infringement could be proved, *All States Plastic Mfg. Co., Inc.* v. *Weckesser Co., Inc.*, 362 F. Supp. 94 (N. D. Ill. 1973).

The -521 patent is entitled "Stereophonic Moving Magnet Phonograph Pickup"; the -522 patent is "Stereophonic Pickup

Cartridge". According to the answers to interrogatories, the claims alleged to have been infringed are 7 through 13 and 15 in the -521 patent, and 2 through 4 and 6 in the -522 patent.[3] Each of these claims purports to be for "an armature-stylus subassembly". However, each one includes or incorporates the following:

> ". . . for a magnetic pickup cartridge comprised of two electromagnet systems each terminating in a pair of spaced-apart pole pieces arranged to describe a common magnetic gap and to form a socket having a recess substantially co-extensive with said gap; said subassembly comprising . . ."

Each claim then proceeds to describe a subassembly. These descriptions all refer to the above-quoted preamble, through reference to "said socket", or "said common gap", and "said gap". These descriptions are not understandable without reference to the preambles.

---

3. Claims 7 through 13 and 15 in the -521 patent read as follows:

> 7. An armature-stylus subassembly for a magnetic pickup cartridge comprised of two electromagnet systems each terminating in a pair of spaced-apart pole pieces arranged to describe a common magnetic gap and to form a socket having a recess substantially co-extensive with said gap; said subassembly comprising a supporting member, a bearing of an elastomeric material having a channel therein retained within said supporting member, an armature comprising a permanent magnet operatively mounted in said bearing channel for angular vibration substantially about a point intermediate the poles of said magnet, and means including a stylus connected with said armature for transmitting vibrations thereto, the portion of said supporting member containing said armature and said bearing being contoured so that it may be inserted axially into the recess of said socket at said common gap and, when so inserted, orients and retains said armature within said gap in operating position.
>
> 8. An armature-stylus subassembly according to claim 7 in which said support member has an enclosed hollow space axially behind said magnet, a damper vane mounted on said magnet in said space, and pasty substance filling said space.

(Footnote continued on next page.)

In addition, the uncontroverted affidavit of the defendant's counsel, Mr. Santisi asserts that the above-quoted preamble was first inserted in the claims of the application for the -522 patent by an Amendment dated December 22, 1960, in order to distinguish these claims over prior art. This additional language was apparently necessary in order to overcome a rejection on the basis of prior art by the Patent Office Examiner.

The uncontroverted affidavit quotes from the plaintiff's arguments made to the Patent Office in connection with the December 22, 1960, Amendment to prove that the preamble was considered to be a limitation on the claims, and thus to distinguish them from prior art:

> 9. An armature-stylus subassembly according to claim 7 in which said support member has a top portion extending along and over said stylus, and having an opening beneath said top portion, said stylus extending through said opening and out of said support member.
>
> 10. An armature-stylus subassembly for a magnetic pickup cartridge comprised of two electromagnetic systems each terminating in a pair of spaced-apart pole pieces arranged to describe a common magnetic gap and to form a socket having a recess substantially co-extensive with said gap, said subassembly comprising a supporting member, a bearing of an elastomeric material having a channel therein retained within said supporting member, an armature comprising a permanent magnet operatively mounted in said bearing channel for angular vibration substantially about a point intermediate the poles of said magnet, and means including a stylus connected with said armature for transmitting vibrations thereto, the portion of said supporting member containing said armature and said bearing being contoured so that it may be inserted axially into the recess of said socket at said common gap, and when so inserted, orients and retains said armature within said gap in operating position, the magnetic axis of said armature being parallel to the axis of the portion of said supporting member containing said armature.
>
> 11. An armature-stylus subassembly for a magnetic pickup cartridge comprised of two electromagnet systems each terminating in a pair of spaced-apart pole pieces arranged to describe a common magnetic gap and to form a socket having a recess substantially co-extensive with said gap, said subassembly com-

(Footnote continued on next page.)

"As presently amended, the claims all define a structure adapted to be used with a stereophonic system having two separate magnetic systems where all the poles form a common gap having a socket therein, and where the supporting member is contoured to fit into the socket thus formed and retain the rubber bearing and magnet therein. No such structure is shown by the references. . . .

"The heart of the presently claimed invention is the removable subassembly comprised of a supporting member having a rubber bearing therein in which is mounted a magnet, and where the supporting member retains the magnet in position in the common gap for proper orientation. . . .

(Footnote continued from preceding page.)

prising a generally sheet-form supporting member, a bearing of an elastomeric material having a channel therein retained within said supporting member, an armature comprising a permanent magnet operatively mounted in said bearing channel for angular vibration substantially about a point intermediate the poles of said magnet, and means including a stylus connected with said armature for transmitting vibrations thereto, the portion of said supporting member containing said armature and said bearing being contoured so that it may be inserted axially into the recess of said socket at said common gap and be frictionally retained therein, and, when so inserted, orients and retains said armature within said gap in operating position.

12. An armature-stylus subassembly for a magnetic pickup cartridge comprised of two electromagnet systems each terminating in a pair of spaced-apart pole pieces arranged to describe a common magnetic gap and to form a socket having a recess substantially co-extensive with said gap, said subassembly comprising a supporting member, having a tubular portion, a bearing of an elastomeric material having a channel therein retained within the tubular portion of said supporting member, an armature comprising a permanent magnet operatively mounted in said bearing channel for angular vibration substantially about a point intermediate the poles of said magnet, and means including a stylus connected with said armature for transmitting vibrations thereto, the tubular portion of said supporting member being contoured so that it may be inserted axially into the recess of said socket at said common gap, and, when so inserted, orients and retains said armature within said gap in operating position.

13. A subassembly according to claim 12 wherein the tubular portion of said supporting member has a square cross-sectional configuration.

* * * * *

"Further, this portion of the supporting member is so contoured that it fits into the common gap of the cartridge where it maintains the armature in the proper operating position. For the high caliber reproduction required of modern cartridges the tolerances and the positioning of the armature is quite critical. Since the tubular portion of the supporting member is contoured to the dimensions of the common gap socket, it automatically orients the magnet in a proper operating position when it is inserted. Moreover, removal and replacement of the needle and armature are extremely simple, since the orientation of the parts is determined by the supporting member. It is submitted that none of these features are shown by any of the references cited."

It is thus evident that in its presentation to the Patent Office, the plaintiff stressed the cooperative relationship of the total combination of the cartridge with the armature-stylus subassembly.

15. An armature-stylus subassembly for a magnetic pickup cartridge comprised of two electromagnetic systems each terminating in a pair of spaced-apart pole pieces arranged to describe a common magnetic gap and to form a socket having a recess substantially co-extensive with said gap; said subassembly having an elongated slim body portion adapted to be thrust end first fully into said socket and to have a snug friction fit therein, said subassembly having four flat sides defining a square cross-section, a slim elongated permanent magnet, having poles at opposite ends, positioned within and along the axis of the body, and a elastomeric bearing engaging the permanent magnet substantially around its mid portion, and leaving its ends free for universal pivoting of the permanent magnet about a point between its poles to cause its opposite poles to approach close to opposite flat sides of the body, and means connected to the permanent magnet through the end of the body and including a stylus extending laterally of the axis of the body in a plane diagonally disposed with respect to the square cross-section.

Claims 2 through 4 and 6 in the -522 patent read as follows:

2. An armature-stylus sub-assembly for a magnetic pickup cartridge comprised of two electromagnet systems each terminating in a pair of spaced-apart pole pieces arranged to described a common magnetic gap and to form a socket having a recess substantially co-extensive with said gap, said sub-

(Footnote continued on next page.)

In addition, it is clear that the -521 patent and the -522 patent anticipate that the stylus subassembly will wear out and must be replaced. Both of these refer to the ease of replacement of these parts (-521 patent, col. 1, lines 55-56; -522 patent, col. 1, lines 66-70).

The question of whether a preamble in a patent claim should be treated as a limitation thereon is one which has often troubled courts. The decision by the United States Court of Customs and Patent Appeals in *Kropa* v. *Robie*, 187 F. 2d 150 (1951), is instructive. The court there attached an appendix listing the decision and rationale in thirty-seven cases dealing with this problem.

The Seventh Circuit recently considered the problem in *Wells Mfg. Corp.* v. *Littelfuse, Inc.*, 547 F. 2d 346 (7th Cir. 1976). The court there held that the patent claim in suit should be interpreted as a combination patent, with the preamble included as a limitation on the claim. Although the case dealt with a special type of claim form known as the "Jepson-type claim", the court set forth the test relevant to all types:

(Footnote continued from preceding page.)

assembly comprising a supporting member, a bearing of an elastomeric material having a channel therein retained within said supporting member, an armature comprising a permanent magnet operatively mounted in said bearing channel for angular vibration substantially about a point intermediate the poles of said magnet, means including a stylus connected with said armature for transmitting vibrations thereto, and spring means connecting said stylus with said supporting member for maintaining proper normal orientation between said stylus and said supporting member, the portion of said supporting member containing said armature and said bearing being contoured so that it may be inserted axially into the recess of said socket at said common gap and, when so inserted, orients and retains said armature within said gap in operating position.

3. A sub-assembly according to claim 2 wherein said spring means is an elastomeric body.

4. A sub-assembly according to claim 2 wherein said spring means is a wire spring one end of which is connected to said stylus and the other end of which is connected to said supporting member.

* * * * *

(Footnote continued on next page.)

"In other cases, the determination of whether elements in the preamble are considered to be part of the patented invention depends upon whether the preamble is necessary to give life and meaning and vitality to the claims or counts. . . . In *Marston, supra*, the court explained the test as follows:

> If the preamble merely states a purpose or intended use and the remainder of the claim completely defines the invention independent of the preamble, it is not a limitation on the claims. On the other hand, if the claim cannot be read independently of the preamble and the preamble must be read to give meaning to the claim or is essential to point out the invention, it constitutes a limitation upon the claim. 353 F.2d at 986."

547 F. 2d at 353 (citations omitted).

In addition, the Court of Appeals found that it is proper to consider both the patent specifications and file history in determining the scope of a claim. 547 F. 2d at 354.

Applying the *Wells* tests to the claims in the -521 and -522 patents, it is apparent that these should be considered as combination claims, consisting of an armature-stylus and a magnetic pickup cartridge. This interpretation is mandated by the fact that the body of the claims cannot be read independently of the preambles, and because the patent descriptions and filing history indicate that the invention was a combination.

(Footnote continued from preceding page.)

6. An armature-stylus subassembly for a magnetic pickup cartridge comprised of two electromagnetic systems each terminating in a pair of spaced-apart pole pieces arranged to describe a common magnetic gap and to form a socket having a recess substantially co-extensive with said gap, said subassembly comprising a supporting member, a bearing of an elastomeric material having a channel therein retained within said supporting member, an armature comprising a permanent magnet operatively mounted in said bearing channel for angular vibration substantially about a point intermediate the poles of said magnet, means including a stylus connected with said armature for transmitting vibrations thereto, and spring means connecting said stylus with said supporting member for maintaining proper

(Footnote continued on next page.)

This conclusion carries with it the conclusion that the defendant's sale of a single part of the combination cannot constitute infringement of the patents, *Well Mfg. Corp.* v. *Littlefuse, Inc., supra.* Accordingly, the defendant is entitled to partial summary judgment on this issue.

In sum, the defendant's motion to dismiss, treated as a motion for summary judgment, is denied in part and granted in part in accordance with this memorandum opinion.

* * * * *

(Footnote continued from preceding page.)

normal orientation between said stylus and said supporting member, said spring means comprising a wire spring having one end secured to said magnet and the other end secured to said support member forwardly of said magnet and at a point on said support member spaced from said magnet and from said stylus, the portion of said supporting member containing said armature and said bearing being contoured so that it may be inserted axially into the recess of said socket at said common gap and, when so inserted, orients and retains said armature within said gap in operative position.

IN THE UNITED STATES DISTRICT COURT
For the Northeastern District of Illinois
Eastern Division

SHURE BROTHERS, INCORPORATED,
Plaintiff,
vs.
KORVETTES, INC., dba E. J. KORVETTE AND OGURA JEWEL INDUSTRY CO., LTD.,
Defendants.

Civil Action
No. 77-C-1609

MEMORANDUM OPINION AND ORDER

This case involves three patents which concern moving magnet phonograph cartridges and styli. The accused device is a stylus assembly sold by the defendant, Korvettes, and identified as Walco Model W582 STD. By memorandum opinion and order dated March 16, 1978, the court ruled that two of the three patents in dispute were non-infringed as a matter of law. The court found that an issue of fact remained on the question of infringement of the third patent.

The case is now before the court on numerous motions. The plaintiff has moved for reconsideration of the March 16, 1978, memorandum opinion and order. In response, the defendant has moved for modification of that order so as to make it effective as a final judgment as to matters determined therein. In addition, the plaintiff has moved for an order striking a "supplemental opposing memorandum" filed by the defendant, and the defendant has responded with a motion to withdraw and refile the brief. Finally, the defendant has moved for summary judgment on the basis of patent misuse.[1]

1. The defendant has also moved for summary judgment on the invalidity of the third patent and claim, Claim 6 of Patent

(Footnote continued on next page.)

A. *Motion for Reconsideration.*

By this motion, the plaintiff requests the court to reconsider the finding that in two of the three patents, U. S. Patent Nos. 3,077,521 (the "-521 patent") and 3,077,522 (the "-522 patent"), the disputed claims are combination claims, and are non-infringed as a matter of law. The court found that the disputed claims were combination claims consisting of an armature-stylus and a magnetic pickup cartridge. In arriving at this conclusion, the court considered the teaching of *Wells Mfg. Corp.* v. *Littlefuse, Inc.*, 547 F. 2d 346 (7th Cir. 1976), and the cases cited therein. In addition the court found parts of the filing history to be relevant in understanding the disputed claims.

The plaintiff contends that the court erred in two respects. First, it is urged that the *Wells* decision involved only Jepson-type claims, and thus that it should not be applied to the instant case. However, the court recognized this distinction, but nevertheless found that the *Wells* case could provide some guidance in interpreting non-Jepson claims. The *Wells* opinion cites *Ex parte Lennon*, 140 U. S. P. Q. 67 (1963), as "instructive" even though it did not involve a Jepson-type claim, and quotes a passage from the ruling which is exactly the notion relied upon by this court in the March 16, 1978, decision:

> ". . . [W]here the body of the claim refers back to structure recited in the preamble and depends for completeness on such structure, then such structure becomes a part of the claimed combination." 547 F. 2d at 353.

The *Wells* court also quotes from *Marston* v. *J. C. Penney Company*, 353 F. 2d 976 (4th Cir. 1965), *cert. denied*, 385 U. S. 974 (1966). Thus, the court's reliance on the analysis in *Wells* was not erroneous.

(Footnote continued from preceding page.)

No. 3,055,988 (the "-988 patent"). However, this motion is not fully briefed. On June 29, 1978, the defendant was given an extension for the filing of a reply memorandum, to 15 days following receipt of the transcript of the deposition of Benjamin Bauer.

Next, the plaintiff contends that the full filing history demonstrates that the disputed claims were limited to the stylus subassembly. In support of this claim, the plaintiff has submitted the complete file histories of the -521 and -522 patents. However, this evidence does not undermine the court's earlier observation that the preamble limitations were added to overcome rejections of the Patent Examiner and that they resulted in claims which describe a cooperative relationship formed by the combination of the cartridge with the armature-stylus subassembly.

In addition to these specific objections, the plaintiff argues that the decision granting partial summary judgment should be set aside because the remaining issues will still have to be tried. However, the rules clearly provide that partial summary judgment would be granted where appropriate, see F. R. C. P. 54, 56. This procedure is helpful in eliminating issues than can be decided as a matter of law.

B. *Defendant's Motion for Direction of Final Judgment as to Non-Infringement of the -521 and -522 Patents.*

Having reconsidered the decision of March 16, 1978, the court has determined that there is no just reason for delay of the entry of a final judgment as to the non-infringement of the -521 and -522 patents. Accordingly, final judgment will be entered in accordance with the memorandum opinion and order of March 16, 1978.

* * * * *

In sum:

(1) The plaintiff's motion for reconsideration is denied.

(2) Final judgment is hereby entered for defendant Korvettes that the stylus subassembly sold by it and identified as Walco Model W582 STD does not infringe plaintiff's patent Nos. 3,077,521 and 3,077,522.

IN THE UNITED STATES DISTRICT COURT
For the District of Maryland

SHURE BROTHERS, INC. *vs.* PEELTONE, INC.	Civil Case No. HM 76-722

Baltimore, Maryland
December 4, 1978

The above-entitled matter continued on trial before the Honorable Herbert F. Murray and a jury at 10:00 A.M.

APPEARANCES

On Behalf of the Plaintiffs:
H. Thomas Howell, Esquire
Sheldon Witcoff, Esquire

On Behalf of the Defendants:
Robert K. Reiter, Esquire

EXCERPT

The Court: The Court appreciates the arguments of counsel in this case. It is not an easy case, I guess no patent case is, because of the technical nature of the subject matter and the fact that the art of inventing useful devices has been described by some people, I guess, as involving arcane mysteries which the layman can't readily grasp, and I don't pretend to be any scientific expert.

In listening to the arguments of counsel and the evidence in this case, certain matters have resolved themselves in my mind,

at least, and I'd like to state what those are. Other matters I think in this case are going to have to be resolved by a jury, and to that extent I would disagree with counsel on both sides, because I think I have to leave some of the matters in this case to the jury.

I also feel that I'm going to let the infringement issue and the trademark issues go to the jury for their determination, but I may say as to the infringement issue that as a legal proposition, I don't find myself in agreement with the argument made by Mr. Reiter that there isn't any infringement here, for basically the same reason that the court found no infringement in *Shure Brothers, Inc.* v. *Korvette's, Inc.*, the case that was decided in the Northern District of Illinois. I think that I disagree with that decision, and the little fuse [sic] case as far as their applicability here is concerned, because I think we are dealing, as Mr. Witcoff has argued in this case, with a Jepsen-type claim. I think the case is factually different from the *Shure Brothers* v. *Korvette's, Inc.*, case because the patented device was the combination device described in Claim 7 and Claim 2 in the two patents here at issue. When one sells a device that is exactly the same, if it be exactly the same then I don't feel that there is any basis for finding it is a repair part or a replacement part, because it is taking the place of a patented item, and to that extent I am in disagreement with the district judge in the *Shure Brothers* v. *Korvette's* case.

I would eliminate that legal issue from the infringement part of the case, and what the jury has to determine are whether the Peeltone device is part by part the same as the Shure device. I though there might be some agreement about that, but I gather that Mr. Reiter is not willing to go that far, and I think then it ought to be resolved by the jury in the context of the whole case.

Those are just informally stated oral thoughts that I have about the issues in this case. That's not to suggest that they are not binding and decisive, but I am not trying to formulate them

with the precision that I would if I were delivering a written opinion about the matter.

So, in summary, the anti-trust counterclaim, unfair competition counterclaim, the Court feels are out of the case and the issues that will be submitted to the jury are those on validity of the patent, infringement of the patents, and trademark infringement.